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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,318	06/14/2002	Francesco Rossi	214771US0PCT	2414

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EXAMINER	
BRUNSMAN, DAVID M	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/926,318	ROSSI ET AL.	
	Examiner	Art Unit	
	David M Brunsman	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's response filed 27 February 2004 has been carefully considered. The claims examined in the first office action were those submitted. The "TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371" Clearly states "A copy of the International Application *as filed* [emphasis added] has been communicated by the International Bureau" and "Amendment to the claims of the International Application under PCT Article 19 (35 U.S.C. ©(3)) *have not been made and will not be made* [emphasis added]. The office has examined the claims of the International Application as directed. The rejection of claims 1-3 and 11-13 and objection to claims 4-10 and 14-21 is moot in view of the cancellation of those claims. New claims 22-41 have been submitted.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22, 25-30 and 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0333299.

The reference teaches a fibrous reinforcing material for bituminous mixes formed by chopping glass filaments to obtain bundles wherein the average filament diameter is approximately 13 microns and the average length is approximately 13mm. The disclosure of approximately 13 microns is indistinguishable from and anticipates the recitation of 12 microns. See, *In re Woodruff*, 16 USPQ2d 1934. The instant specification teaches that the selected length and diameter of the desired fibers allow agglomeration of said fibers into flakes. As no specific method steps are recited or disclosed to cause such agglomeration into flakes, flake formation must be intrinsic. Otherwise, the instant specification would be deficient in failing to teach one of ordinary skill in the art how to make the invention.

Therefore, the reference anticipates the instant claims. Applicant response argues that flake formation is not intrinsic, but provides not evidence thereto. The response does not address the lack of a teaching in the application as filed what steps are necessary to ensure flake formation if said flake formation is not intrinsic. The amendment of the application to include a statement of record that flake formation would not be intrinsic requires that a rejection be made under the first paragraph of 35 U.S.C. 112. The recitation of "rotating blades" in claim 37 is insufficient to distinguish the claim over the reference. The reference recites that the fibers are chopped. There is no evident difference or evidence of record of a difference that a specific apparatus, one using a rotating blade, would materially effect that nature of the chopped fibers.

Claims 22-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no teaching, in the specification as originally filed, that would allow one of ordinary skill in the art to determine the steps required to ensure that the chops fibers agglomerate in the form of flakes.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 23, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0333299, as applied above.

The difference between claim 31 and the instant claims is the utilization of waste glass as the source for the glass. It would have been obvious to one of ordinary skill in the art to use the least expensive source for a material. See, *In re Clinton*, 188 USPQ 365. The further difference between claims 23 and 32 is the use of E-glass (low alkali calcium alumina borosilicate). Page 5, lines 19-21 of the instant specification admit that E-glass is known to have a number of superior properties such as strength. It would have been obvious to one of ordinary skill in the art to employ e-glass because it is recognized in the art to have superior properties such as strength. The desire to have improved strength in paving compositions is evident on its face. Furthermore, the abstract of the reference itself teaches the desirability of increased strength for paving compositions.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 28 the term "so-called" renders the scope and meaning of the claim indefinite. It appears to suggest the term "minimum length" is erroneous. In claim 33 the use of quotation marks around "textile" and "roving" renders the scope of the claim indefinite in that it suggests these terms are to be read as having something other than their plain meaning.

The prior art of record does not teach a fibrous reinforcing material for bituminous mixes for road pavements of claim 22 wherein the material includes a mixture of glass filaments of two materially different average diameters.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David M Brunsman
Primary Examiner
Art Unit 1755

DMB